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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,120	03/11/2004	Robert G. McGuiness	7049-1	4681

7590

06/29/2004

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EXAMINER

FRIDIE JR, WILLMON

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/797,120	Applicant(s) MCGUINESS, ROBERT G.	
	Examiner Willmon Fridie	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
3. Claims 1-4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zumberge in view of McGuiness or Shanley.

Zumberge discloses a relatively planar sheet of material (10) having a first side and a second side, the second side having information placed thereon; and the first side having an adhesive sheet (12) attached thereto with the same information placed thereon as the second side.

Zumberge lacks the disclosure of a first side having a static cling sheet attached thereto.

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McGuiness (1) and Shanley (10) both disclose the use of static cling sheets for displaying information. It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the adhesive sheet (12) of Zumberge (which has the same information placed thereon as the second side) with the static cling sheet of either McGuiness or Shanley since the selection of any of these known equivalents to display information and to allow the user to transfer it to another surface would be within the level of ordinary skill in the art.

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zumberge in view of McGuiness or Shanley as applied to claims 1-4 above, and further in view of Paz-Pujalt et al..

Zumberge as modified by McGuiness or Shanley discloses the claimed invention except for a surface having information/indicia embossed thereon. Paz-Pujalt et al. teaches that it is well known in the art to emboss information/indicia on a surface (see column 4, lines 60-64). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Zumberge as modified by McGuiness or Shanley with embossed information on its second side in the manner as taught by Paz-Pujalt et al in order to improve the aesthetic appearance of the assembly and to provide a tactile display means.

5. Claims 1-4 and 6-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shanley.

Shanley discloses the claimed invention except for the specific arrangement and/or content of indicia (printed matter) set forth in the claim(s). It is noted that most auto service forms have indicia on both sides and are well known in the art. Further it

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would have been obvious to one having ordinary skill in the art at the time the invention was made to locate identical information on the static cling label (10) and the back side of the form (58) since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of indicia does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability.

6. Claims 1-4 and 6-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGuinness.

McGuinness discloses the claimed invention except for the specific arrangement and/or content of indicia (printed matter) set forth in the claim(s) at specific locations. It would have been obvious to one having ordinary skill in the art at the time the invention was made to locate the same information on the static cling sheet that is present on the second side (the inner section of the card adjacent the front cover), since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. V Bemis Co.*, 193USPQ8.

Further, It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the claimed information since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the

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substrate it will not distinguish the invention from the prior art in terms of patentability.

In re Gulack 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of information/indicia does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability.

Conclusion

In order to reduce pendency and avoid potential delays, Group 3700 is encouraging FAXing of responses to Office actions directly into the Group...*Official-(703)872-9302...After Final-(703) 872 9303*. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into Group 3700 will be promptly forward to the examiner.

Any inquiries concerning issues other than the substantive content of this and previous communications, such as missing references or filed papers not acknowledged, should be directed to the Customer Service Representative, Tech Center 3700, (703) 306-5648.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Tech Center receptionist whose telephone number is (703) 308-1148.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to W. Fridie, jr. whose telephone number is (703) 308-1866.



WILMON FRIDIE, JR.
PRIMARY EXAMINER